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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,793	11/30/2000	Thomas Lange	P-4581	2701

24209   7590   10/20/2004

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EXAMINER
HUTTON JR, WILLIAM D

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/728,793	LANGE, THOMAS	
	Examiner	Art Unit	
	Doug Hutton	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>21 July 2004</u>.

2a)☒ This action is **FINAL**.　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-17,19-22,25 and 26* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-17,19-22,25 and 26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>30 November 2000</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☒ All　b)☐ Some * c)☐ None of:

　　　1.☒ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's Response

In Applicant's Response dated 21 July 2004, Applicant amended Claims 1, 3, 7, 13-15, 19 and 25, cancelled Claims 6, 18, 23 and 24, and argued against all rejections previously set forth in the Office Action dated 21 April 2004.

Since Claims 6, 18, 23 and 24 have been cancelled, all previous rejections for those claims are withdrawn. The 102 rejections based on Aitken for Claims 1-10 and 13-25 are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7-17, 19-22, 25 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Tittel, Ed et al., **HTML 4 for Dummies**, IDG Books Worldwide, Inc. (1998).

Claim 1:

Tittel discloses a method of inserting a data object into a computer-generated document (see Chapter 7 -- "Introducing the Unrepresentable: HTML Entities"), comprising:

- converting a user selected text portion in said computer-generated document containing at least one text instruction symbol and at least one text character, which is not included in said text instruction symbol, into a data object, wherein said user selected text portion comprises text representing a formula (Tittel discloses this limitation in that HTML includes "entities," which are used to add special symbols into a web document. For example, if a web page designer wanted to put the mathematical equation " $\int x=x^2$ " onto a web document, then he would type "∫2x=x²" into the HTML document. This "user-selected" portion of the document is the "text portion," and it includes "text instruction symbols" ("∫" → would be converted into " $\int$; "²" → would be converted into "^{2}") and "text characters" ("2x" and "x") that are not "included in the text instruction symbol." The entire equation would be displayed as " $\int x=x^2$ " when viewed using a browser.); and

- returning said data object for insertion in said computer-generated document wherein said data object comprises said formula and further wherein said at least one text character which is not included in said text instruction symbol remains unchanged during the converting (Tittel discloses this limitation in that HTML

inserts the mathematical formula into the web document with no change in the

"text characters" during the conversion – "2x" and "x").

Claim 2:

Tittel discloses the method of Claim 1, further comprising:

- inserting said at least one text instruction symbol in the form of text characters

  into the computer-generated document (As explained in the above rejection for

  Claim 1, Tittel discloses this limitation in that the "text instruction symbols" are

  "∫" and "²".).

Claim 3:

Tittel discloses the method of Claim 2, further comprising:

- selecting said text portion in said computer-generated document containing said

  at least one text instruction symbol (Tittel discloses this limitation in that the web

  page author "selects" the portion of the web page to be converted during the

  creation or editing of the web page. The "selected portion" of the web page

  includes "text instruction symbols," as explained in the above rejection for Claim

  1.).

Claim 4:

Tittel discloses the method of Claim 1, wherein the data object comprises a

mathematical formula (As explained in the above rejection for Claim 1, Tittel discloses

this limitation.).

Claim 5:

Tittel discloses the method of Claim 1, wherein the data object comprises at least

one Greek character (Tittel discloses this limitation in that the HTML entity "Σ"

represents "Σ").

Claim 7:

Tittel discloses the method of Claim 1, further comprising:

- inserting the returned data object into the computer-generated document at a

  position of the selected text portion (Tittel discloses this limitation in that the

  mathematical equation is inserted at the position selected by the web page

  author.).

Claim 8:

Tittel discloses the method of Claim 7, wherein content surrounding the data

object has a format, and said method further comprises formatting the returned data

object using said format (Tittel discloses this limitation in that the text "surrounding" the

mathematical equation is formatted in a particular font and size and the "returned"

mathematical equation is formatted using the same font and size).

Claim 9:

Tittel discloses the method of Claim 1, further comprising:

- storing the data object with the computer-generated document (Tittel discloses

    this limitation in that the mathematical equation is stored with the web document).

Claim 10:

Tittel discloses the method of Claim 1, wherein the data object is reconvertible

into the text portion representing the data object (Tittel discloses this limitation in that

the mathematical equation can be "reconverted into the text portion" by revealing the

source code for the web document).

Claim 11:

Tittel discloses the method of Claim 1, wherein said method is downloaded (Tittel

discloses this limitation in that web pages are downloaded from a server).

Claim 12:

Tittel discloses the method of Claim 1, wherein said method is stored on a first

computer system and said computer-generated document is stored on a second

computer system (Tittel discloses this limitation in that the method is performed at the client computer and the document is stored on a server).

Claims 13-17 and 19-22:

These claims are simply for computer software that performs the method of Claims 1-5 and 7-10, respectively. Thus, Tittel discloses every limitation of Claims 13-17 and 19-22 using the same rationale set forth in the above rejections for Claims 1-5 and 7-10.

Claim 25:

Tittel discloses a computer system, comprising:

- a processor (Tittel discloses this limitation in that it includes a client computer); and

- a memory, coupled to said processor, storing instructions for a method (Tittel discloses this limitation in that it includes a client computer), where upon execution of said instructions on said processor, said method comprises:

  o converting a user selected text portion in said computer-generated document containing at least one text instruction symbol and at least one text character, which is not included in said text instruction symbol, into a data object, wherein said user selected text portion comprises text representing a formula (Tittel discloses this limitation, as indicated in the above rejection for Claim 1); and

    o returning said data object for insertion in said computer-generated

        document wherein said data object comprises said formula and further

        wherein said at least one text character which is not included in said text

        instruction symbol remains unchanged during the converting (Tittel

        discloses this limitation, as indicated in the above rejection for Claim 1).

Claim 26:

Tittel discloses the computer system of Claim 25, wherein said memory is

coupled to said processor by a network (Tittel discloses this limitation in that it includes

a client computer and a server that is part of the Internet. Thus, the memory is coupled

to the processor "by a network.").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-17, 19-22, 25 and 26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Martel, Jr. et al., U.S. Patent No. 5,251,292, in view of Holm et al.,

U.S. Patent No. 5,850,629.

Claim 1:

Martel discloses a method of inserting a data object into a computer-generated

document (see Column 1, Lines 7-10 – Martel discloses this limitation in that the

equation editor system creates and enters mathematical equations into word processing

documents), comprising:

- converting a user selected text portion of said computer-generated document

  (see Column 3, Lines 26-54 – Martel discloses this limitation in that the equation

  editor system allows a user to choose which portion of the document to convert;

  the user does so by going into the equation editor when he gets ready to enter an

  equation into the document; thus, the "text portion" that is "converted" is

  "selected" by the user) including at least one text instruction symbol and at least

  one text character, which is not included in said text instruction symbol, into a

  data object, wherein said user selected text portion comprises text representing a

  formula (see Figures 1-2; see Column 3, Lines 40-45 – Martel discloses this

  limitation in that the equation editor allows the user to type in the textual

  description "SQRT x" to generate the square root symbol $\sqrt{x}$; thus, "SQRT" is a

  "text instruction symbol," and "x" is a "text character" that is "not included in the

  text instruction symbol;" this input is converted into a data object, as seen in Line

  45 of the cited text; finally, the "text portion" comprises a "formula," as clearly

  indicated in the cited text); and

- returning said data object for insertion in said computer-generated document

  wherein said data object comprises said formula and further wherein said at least

  one text character which is not included in said text instruction symbol remains

unchanged during the converting (see Figures 1-2; see Column 3, Line 45; see Column 3, Line 61 through Column 4, Line 1 – Martel discloses this limitation in that the equation editor generates the data for printing the equation into the document; as seen in Column 3, Line 45, the "text character" remains unchanged during the conversion).

Martel fails to expressly disclose allowing the user to select the text *in* the document that is to be converted.

Holm teaches a method of inputting data into a conversion process, comprising:

- allowing the user to select the text in the document that is to be converted (see Figure 1; see Column 3, Lines 15-35 – Holm discloses this limitation in that user interface allows the user to select text within a word processing document by highlighting that portion of the text that is to be converted),

for the purpose of indicating the text in the document that is to be copied and pasted onto the clipboard and input into the conversion process (see Column 3, Lines 54-65).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Martel, to include:

- allowing the user to select the text in the document that is to be converted,

for the purpose of indicating the text within the document that is to be copied and pasted onto the clipboard and input into the conversion process, as taught by Holm.

Claim 2:

Martel discloses the method of Claim 1, further comprising:

- inserting said at least one text instruction symbol in the form of text characters

 into the computer-generated document (see Figures 1-2; see Column 3, Lines

 35-45 – Martel discloses this limitation in that, in the textual description "SQRT

 x," "SQRT" is a "text instruction symbol" that is input by typing in the letters from

 the keyboard; the "text instruction symbol" is inserted "into the computer-

 generated document" through the conversion process performed by the equation

 editor).

Claim 3:

Martel, in view of Holm, discloses/teaches the method of Claim 2, as indicated in

the above discussion.

Martel also discloses:

- selecting said text portion of said computer-generated document containing said

 at least one text instruction symbol (as indicated in the above rejection for Claim

 1, Martel discloses this limitation).

Martel fails to expressly disclose allowing the user to select the text portion *in* the

document.

Holm teaches a method of inputting data into a conversion process, comprising:

- allowing the user to select the text in the document that is to be converted (see

 Figure 1; see Column 3, Lines 15-35 – Holm discloses this limitation in that user

interface allows the user to select text within a word processing document by

highlighting that portion of the text that is to be converted),

for the purpose of indicating the text within the document that is to be copied and pasted

onto the clipboard and input into the conversion process (see Column 3, Lines 54-65).

Accordingly, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the method, disclosed in Martel, to include:

- allowing the user to select the text in the document that is to be converted,

for the purpose of indicating the text within the document that is to be copied and pasted

onto the clipboard and input into the conversion process, as taught by Holm.

Claim 4:

Martel discloses a data object that comprises a mathematical formula (see

Figures 1-2 – Martel discloses this limitation, as clearly indicated in the cited figures).

Claim 5:

Martel discloses a data object that comprises at least one Greek character (see

Figures 1-2 – Martel discloses this limitation, as clearly indicated in the cited figures).

Claim 7:

Martel discloses:

- inserting the returned data object into the computer-generated document at a

  position of the selected text portion (see Column 3, Line 55 through Column 4,

Line 1 – Martel discloses this limitation in that the equation editor generates the data for printing the equation into the document; the equation is inserted "at a position of the selected text portion" in that it is placed in the document at a position where the user chooses to enter the equation).

Claim 8:

Martel discloses content surrounding the data object having a format, and said method further comprises formatting the returned data object using said format (see Column 2, Lines 19-36 – Martel discloses this limitation in that equation editors typically automatically formats the equations that are entered into the document).

Claim 9:

Martel discloses:

- storing the data object with the computer-generated document (Martel discloses this limitation in that the equation is "stored with the document" when the user saves the document).

Claim 10:

Martel discloses a data object that is reconvertible into the text portion representing the data object (see Column 4, Lines 33-48 – Martel discloses this limitation in that the equation editor system saves the textual description as part of the

document, and, if the user later wishes to edit the equation, reads the textual description from memory into the equation editor for further modification).

Claim 11:

As indicated in the above discussion, Martel, in view of Holm, discloses/teaches the method of Claim 1.

Martel, in view of Holm, fails to expressly disclose that the method is downloaded. However, it was well-known by one of ordinary skill in the art at the time the invention was made to place an editing tool, like the equation editor, on a computer network server so that it can be downloaded by peripheral users of the computer network for the purpose of providing use of the tool to all peripheral users.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of inserting a data object into a computer-generated document, disclosed in Martel, in view of Holm, to download the method for the purpose of providing use of the tool to all peripheral users of the computer network.

Claim 12:

As indicated in the above discussion, Martel, in view of Holm, discloses/teaches the method of Claim 1.

Martel, in view of Holm, fails to expressly disclose that the method is stored on a first computer system and said computer generated document is stored on a second

computer system. However, it was well-known by one of ordinary skill in the art at the time the invention was made to place an editing tool, like the equation editor, on a server of a first computer network and save the documents on a second computer network so that users of the second computer network can remotely access the editing tool and save the documents that they create on a local computer.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of inserting a data object into a computer-generated document, disclosed in Martel, in view of Holm, to store the method on a first computer system and store the computer generated document on a second computer system for the purpose of allowing the users of the second computer network to remotely access the editing tool yet save the documents that they create on a local computer.

Claims 13-17 and 19-22:

These claims are simply for computer software that performs the method of Claims 1-5 and 7-10, respectively. Thus, Martel, in view of Holm, discloses/teaches every limitation of Claims 13-17 and 19-22 using the same rationale set forth in the above rejections for Claims 1-5 and 7-10.

Claim 25:

Martel discloses a computer system, comprising:

- a processor (see Column 3, Line 29); and

- a memory, coupled to said processor, storing instructions for a method (see

    Column 3, Lines 26-34), where upon execution of said instructions on said

    processor, said method comprises:

    o converting a user selected text portion of said computer-generated

        document including at least one text instruction symbol and at least one

        text character, which is not included in said text instruction symbol, into a

        data object, wherein said user selected text portion comprises text

        representing a formula (as indicated in the above rejection for Claim 1,

        Martel discloses these limitations); and

    o returning said data object for insertion in said computer-generated

        document wherein said data object comprises said formula and further

        wherein said at least one text character which is not included in said text

        instruction symbol remains unchanged during the converting (as indicated

        in the above rejection for Claim 1, Martel discloses this limitation).

    Martel fails to expressly disclose allowing the user to select the text __in__ the

document that is to be converted.

    Holm teaches a method, performed on a computer system, for inputting data into

a conversion process, comprising:

- allowing the user to select the text in the document that is to be converted (see

    Figure 1; see Column 3, Lines 15-35 – Holm discloses this limitation in that user

interface allows the user to select text within a word processing document by

highlighting that portion of the text that is to be converted),

for the purpose of indicating the text in the document that is to be copied and pasted

onto the clipboard and input into the conversion process (see Column 3, Lines 54-65).

Accordingly, it would have been obvious to one having ordinary skill in the art at

the time the invention was made to modify the computer-implemented method,

disclosed in Martel, to include:

- allowing the user to select the text in the document that is to be converted,

for the purpose of indicating the text within the document that is to be copied and pasted

onto the clipboard and input into the conversion process, as taught by Holm.

Claim 26:

This claim is for a computer network that performs the method of Claims 11 and

12. Thus, this claim is rejected using the same rationale.

Response to Arguments

Applicant's arguments filed 21 July 2004 have been fully considered but they are

not persuasive.

Arguments for Claims 1, 13 and 26:

Applicant argues that Martel fails to disclose "user selected text" that is "in the computer generated document" because Martel discloses "using a text editor and entering the information directly into the [equation] editor." See *Applicant's Response;* Page 10, first full paragraph.

Applicant's arguments have been considered but are moot in view of the new grounds of rejection. As indicated in the above 103 rejections, the only difference between the present invention and the invention disclosed in Martel is the method of inputting text into the converter. As demonstrated in Holm, this difference was known by those of ordinary skill in the art at the time the invention was made and thus is not a patentable difference.

Applicant argues that Tittel fails to disclose "selectively handling" only a portion of the web page because the entire web page is converted when a web page is processed. See *Applicant's Response;* Page 11, fifth full paragraph.

Examiner disagrees.

The pertinent language of the claims recites: "converting a user selected text portion in said computer-generated document . . . into a data object" (see Claim 1, Lines 3-7). This language reads on Tittel, as indicated in the above rejection set forth for Claim 1.

The "computer-generated document" in Tittel is the HTML document/web page. The "user" in Tittel is the web page author. The "user selected text portion" is in that

portion of the HTML document/web page where the user wants to put a mathematical equation. This "user selected text portion" is "converted into a data object" in that the HTML is converted into the mathematical formula when viewed using a browser.

During this conversion, only the HTML entities are actually converted. The remaining text is unchanged. For instance, in the example given in the above rejection for Claim 1, both "2x" and "x" remain unchanged during the conversion process.

Thus, Tittel does disclose every limitation of Claim 1.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
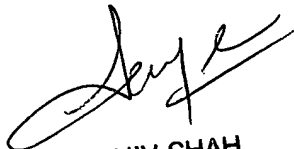
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (703) 305-1701. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

WDH
October 5, 2004

SANJIV SHAH
PRIMARY EXAMINER